

## **REMARKS**

Favorable reconsideration and allowance of the present application in view of the foregoing amendments and following remarks are respectfully requested.

Currently, claims 1 through 16 are pending in the application. Claim 1 is an independent claim, with claims 2 through 8 depending therefrom. Claims 9 and 10 are independent claims, and claims 11 through 16 depend multiply therefrom.

Applicant has carefully considered the Examiner's Action of March 7, 2003 and the references cited therein. The following is a brief summary of the Action. Original claims 1 through 3, 6, and 8 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by Belgian reference # 529802. Original claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference. Original claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference in view of De La Cruz (U. S. Patent No. 4,906,503). Original claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference in view of Fisher (U. S. Patent No. 965,097). Original independent claim 9 and multiple dependent claims 11, 14, 15, and 16 as depending from original claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference in view of Born (U. S. Patent No. 1,751,614). Original multiple dependent claim 12 as depending from original claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference and Born as applied to original claim 9 and further in view of De La Cruz. Original multiple dependent claim 13 as depending from original claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Belgian reference and Born as applied to original claim 9 and further in view of Fisher. Original claim 10 and claims 11 through

16 depending therefrom stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, but were indicated to be allowable if rewritten or amended to overcome such rejection. There are no objections either to the drawings or to the specification.

Claim 10 has been herein amended to overcome the 35 U.S.C. § 112, ¶ 2 rejection, and it is respectfully urged that claim 10, as amended, and also therefore claims 11 through 16 depending therefrom, are now in condition for allowance.

Applicant respectfully submits that independent claim 1, and thus dependent claims 2, 3, 6, and 8, are allowable over Belgian reference # 529802. To anticipate, every element and limitation of the claimed invention must be found in the Belgian reference. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). A determination that a patent is invalid as being anticipated under 35 U.S.C. § 102(b) requires a finding that “each and every limitation is found either expressly or inherently in a single prior art reference.” Celeritas Techs. Ltd. v. Rockwell Int’l Corp., 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998). However, the Belgian reference does not disclose the third limitation of claim 1, “a plurality of elongated flexible elements, each said element being secured to said upper edge of said banner and being passable over a portion of a frame assembly and moveable relative thereto for opening said banner and securing same to said frame assembly” (emphasis added). Instead, the Belgian reference only includes elongated elements carried by a banner at

the rear of the frame and holding the banner to the frame; such elements in the Belgian reference do not open the banner for display. Because the limitation of elongated elements being passable over a portion of a frame assembly and moveable relative thereto, and particularly for opening the banner, is not disclosed by the Belgian reference, it cannot anticipate claim 1 pursuant to 35 U.S.C. § 102(b). Because claims 2, 3, 6, and 8 depend from claim 1 and therefore also include the third limitation of claim 1, neither can the Belgian reference anticipate them. For these reasons, claims 1, 2, 3, 6, and 8 should be allowed over Belgian reference # 529802.

Belgian reference # 529802, either alone or in combination with other references, is cited pursuant to 35 U.S.C. § 103(a) in the rejections of claims 4, 5, 7, 9, and multiple dependent claims 11 through 16 as depending from claim 9. However, to render a claimed invention obvious, a reference or references must teach, suggest, or otherwise provide an incentive that suggests the desirability of making the combination that is the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686 (Fed. Cir. 1987). The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The fact that a solution to a problem is simple or appears so when viewed with hindsight does not mean that the solutions of a claimed invention were obvious when they were conceived. Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 64 S.Ct. 593, 60 U.S.P.Q. 386 (1944). The patent laws do not require complexity in order to achieve a patentable invention. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1572 (Fed. Cir. 1987), cert. denied, 1075 S.Ct. 2187 (1987).

Neither the Belgian reference nor the other references cited in combination with it in the rejections of claims 4, 5, 7, 9, and multiple dependent claims 11 through 16 as depending from claim 9, disclose, teach, suggest, or make obvious the third limitation of claim 1 (from which claim 4 depends) or the third limitation of claim 9. Claim 4, depending from claim 1, includes the limitation, "a plurality of elongated flexible elements, each said element being secured to said upper edge of said banner and being passable over a portion of a frame assembly and moveable relative thereto for opening said banner and securing same to said frame assembly" (emphasis added). Claim 9 includes the limitation, "a plurality of elongated flexible elements, each flexible element having one end secured to an upper peripheral edge of said banner, each flexible element passing around a said top end of a said vertical support post and being movable relative thereto for holding said banner with respect to said support members to permit viewing of the indicia thereon" (emphasis added). The Belgian reference includes no disclosure relative to either. As noted above, the Belgian reference only includes elongated elements carried by a banner at the rear of the frame and holding the banner to the frame. Therefore, as to original claim 7, against which only the Belgium reference is cited, there is no disclosure, teaching, suggestion, or motivation for use of the elongated flexible elements in the manner claimed. Likewise, no such disclosure, teaching, suggestion, or motivation can be supplied by the Belgium reference as to claims 4, 5, 9, and 11 through 16.

As to claim 4, against which both the Belgium reference and De La Cruz are cited, De La Cruz only discloses "cords," "elastic cords," "shock cords," and "bungee cords" for use in holding a banner. No disclosure, teaching, suggestion, or motivation is

*same* provided for such cords being passable over a portion of the frame and moveable relative thereto for opening the banner. Furthermore, the Belgium reference includes no teaching for use of polymeric film, and De La Cruz contains no teaching of use of its banner in an apparatus such as that disclosed by the Belgium reference – there existed no motivation to combine the references.

Likewise, as to claim 5, against which both the Belgium reference and Fisher are cited, Fisher only discloses using cords in the place of a rigid member along the top of a banner. Again, no disclosure, teaching, suggestion, or motivation is provided for such cords being passable over a portion of the frame and moveable relative thereto for opening the banner.

As to claim 9, against which both the Belgium reference and Born are cited, the only use of a cord or “elastic flexible element” is that of tying the disclosed frame together, “binding” it in a set-up position. No disclosure, teaching, suggestion, or motivation is provided for such cords passing around a top end of a support post and being movable relative thereto for holding the banner relative to the support frame.

Finally, as to claims 11 through 16 as depending from claim 9, the analysis hereinabove of the Belgium reference, De La Cruz, Fisher, and Born likewise apply.

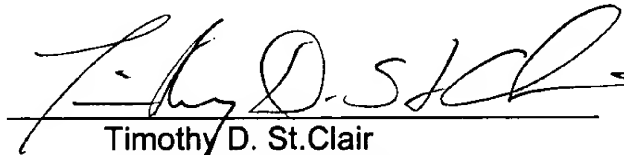
In view of the foregoing amendments and comments, inasmuch as all outstanding issues have been addressed, Applicant respectfully submits that the present application is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the within response, however, the Examiner is invited to telephone the undersigned at her convenience.

If any fee beyond that submitted herewith, or extension of time is required to obtain entry of this Amendment, the undersigned hereby petitions the Commissioner to grant any necessary time extension and authorizes charging Deposit Account No. 04-1403 for any such fee not submitted herewith.

Respectfully submitted,

DORITY & MANNING, ATTORNEYS AT LAW, P.A.

July 17, 2003

A handwritten signature in black ink, appearing to read "Timothy D. St. Clair", is written over a horizontal line.

Timothy D. St. Clair  
Registration No. 48,316

Post Office Box 1449  
Greenville, South Carolina 29602-1449

Telephone: 864-271-1592  
Facsimile: 864-233-7342